

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Examiner: Jacob Y. Choi
Group Art Unit: 2875

In re Application of: CHOI, Daniel S.

Serial No: 10/603,568

Filing Date: 25 JUNE 2003

For: Removable Light

APPEAL BRIEF

Mail Stop APPEAL BRIEF – PATENTS
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Appellants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decisions of the Examiner of Groups Art Unit 2875 dated Sept. 5, 2006, rejecting Claims 1-13 and 15-30. Please charge the fee of \$500 (large entity) for filing this brief and all other fees that may be required to Deposit Account No. 02-0400 (Baker & McKenzie). When identifying such a withdrawal, please use our Attorney Docket No. WEB-922-CIP.

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I. REAL PARTY IN INTEREST

The real party in interest is Weber-Stephen Products Co., the assignee of the patent application at issue. Weber-Stephen Products Co. is an Illinois corporation having a place of business at 200 East Daniels Road, Palatine, Illinois 60067.

II. RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences with regard to the present application.

III. STATUS OF CLAIMS

Claims 1-44 are pending in this case. Claims 1-13 were rejected. Claim 14 was objected to as being dependent upon a rejected base claim, but the Examiner has indicated that the claim would be allowable if rewritten in independent form. Claims 15-30 were rejected. Claims 31-44 were withdrawn from consideration in accordance with a restriction requirement..

The Appellants are appealing the rejection of claims 1-13 and 15-30.

IV. STATUS OF AMENDMENTS

The Appellants did not file any amendments subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a light fixture for a barbecue grill which is relatively inexpensive and is easy to manufacture, assemble and connect to the barbecue grill. (*See*, para. [0013])¹. The light fixture of the present invention can be integrated into a new barbecue grill or can be utilized as a retrofit assembly on existing barbecue grills. (*See*, para. [0013]). A typical barbecue grill incorporates a cooking vessel 14, comprising an upper member 18 (or lid) and a lower member 20 (or firebox), which is supported by a portable cart 16. (*See*, para. [0067]). The lower member 20 usually includes a cooking grid 22 (or surface) for supporting the food to be cooked and the upper member 18 is typically attached to the lower member 20 by a hinge. (*See*, para. [0067]; Fig. 3). The hinge defines horizontal pivot axis for the upper member 18, whereby the pivot axis is disposed near a rear side of the upper member 18. (*See*, para. [0067]; Fig. 3). The upper member 18 includes a handle 24 near a front side of the upper member 18, which allows a user to pivot the upper member 18 between open and closed positions. (*See*, para. [0067]; Fig. 3).

In one embodiment of the present invention, the light fixture 112 is attached to the upper member 18 (or lid) of a barbecue grill. (*See*, para. [0068]; Fig.3). In another embodiment of the present invention, the light fixture 112 is secured to the handle 24 of the barbecue grill. (*See*, para. [0068]; Fig. 2). In the preferred embodiment of the present invention, the light fixture 112 is attached to the handle in such a manner that the illumination provided by the light is directed at the cooking grid 22 at substantially every angle of opening of the upper member of the barbecue grill. (*See*, para. [0069]; Fig. 3).

¹ All references to the application herein are made to the published application, US2004/0032729 A1.

In the embodiment of independent claim 1, a barbecue grill is provided having an upper member 18 and a lower member 20 defining a cooking chamber, the cooking chamber having a cooking grid 22, the upper member 18 being hingedly secured to the lower member 20, and the upper member 18 covering the lower member in a closed position. (*See*, para. [0069]; Fig. 2, 3). Independent claim 1 is drafted in Jepson format, wherein the improvement comprises a light 112 having a fixture 128, 128a, 128b and a removable first pod 166. (*See*, para. [0082]; Fig. 8-19b). The fixture 128, 128a, 128b is adapted to be secured to the barbecue grill, (*see*, para. [0085], [0100]; Fig. 8, 13, 16-18), and includes a first mating member 78, 178, 178a, 178b, (*see*, para. [0088]; Fig. 8-19b). The removable first pod 166 has an illumination device 130 and a second mating member 180, wherein the second mating member 180 is adapted to removably engage the first mating member 78, 178, 178a, 178b to removably secure the pod 166 to the fixture 128, 128a, 128b. (*See*, para. [0089]; Fig. 8-19b).

In the embodiment of claim 15, a barbecue grill is provided having an upper member 18 and a lower member 20 defining a cooking chamber, the lower member 20 having a grilling surface 22, and the upper member 18 having a handle 24 and being hingedly secured to the lower member 20. (*See*, para. [0069]; Fig. 2, 3). Independent claim 15 is drafted in Jepson format, wherein the improvement comprises a modular light 112 having a housing 128, 128a, 128b and a removable first pod 166. (*See*, para. [0082]; Fig. 8-19b). The housing 128, 128a, 128b has a connector 150, 152, 190 to secure the housing to the barbecue grill handle 24. (*See*, para. [0085], [0100]; Fig. 8, 13, 16-18). The housing 128, 128a, 128b also includes a first mating member 78, 178, 178a, 178b, (*see*, para. [0088]; Fig. 8-19b). The removable first pod 166 has an illumination device

130 and a second mating member 180, wherein the second mating member 180 is adapted to removably connect to the first mating member 78, 178, 178a, 178b to removably secure the pod 166 to the housing 128, 128a, 128b. (*See*, para. [0089]; Fig. 8-19b). The pod 166 also has an independent internal power source 132 for illuminating the illumination device 130 and a manual switch 138 which is electrically connected to the internal power source 132 to control illumination of the illumination device 130. (*See*, para. [0090]-[0098]; Fig. 10-12). Both the first mating member 78, 178, 178a, 178b and the second mating member 180 are modular such that the pod 166 can be attached to various housings 128, 128a, 128b, and the housing 128, 128a, 128b can be attached to various pods 166. (*See*, para. [0082], [0090], [00100]; Fig. 8, 16-18).

In the embodiment of claim 27, a barbecue grill is provided having an upper member 18, a lower member 20, a hinge, and a handle 24, wherein the hinge secures the upper member 18 to the lower member 20 such that the upper member 18 rotates about a horizontal axis. (*See*, para. [0069]; Fig. 2, 3). The upper member 18 covers the lower member 20 in a closed position. (*See*, para. [0069]; Fig. 2, 3). The upper member 18 and the lower member 20 define a cooking chamber, which has a cooking grid 22. (*See*, para. [0069]; Fig. 2, 3). The handle 24 is attached to the upper member 18 and is generally parallel to the horizontal axis. (*See*, para. [0069]; Fig. 2, 3). Independent claim 27 is drafted in Jepson format, wherein the improvement comprises a modular light 112 having a housing 128, 128a, 128b, a removable first pod 166, and a removable second pod 168. (*See*, para. [0082]; Fig. 8). The housing 128, 128a, 128b is attached to the barbecue grill handle 24. (*See*, para. [0085], [0100]; Fig. 8, 13, 16-18). The housing 128, 128a, 128b also includes a plurality of first mating members 78, 178, 178a, 178b, (*see*, para. [0088];

Fig. 8-19b). The removable pods 166, 168 each have an illumination device 130 and a second mating member 180, wherein the second mating member 180 is adapted to removably connect to the first mating member 78, 178, 178a, 178b to removably secure the pod 166 to the housing 128, 128a, 128b. (*See*, para. [0089]; Fig. 8-19b). The pods 166, 168 also each have an independent internal power source 132 for illuminating the illumination device 130 and a manual switch 138 which is electrically connected to the internal power source 132 to control illumination of the illumination device 130. (*See*, para. [0090]-[0098]; Fig. 10-12). Both the first mating members 78, 178, 178a, 178b and the second mating members 180 are modular such that the pods 166, 168 can be attached to various housings 128, 128a, 128b, and the housing 128, 128a, 128b can be attached to various pods 166, 168. (*See*, para. [0082], [0090], [00100]; Fig. 8, 16-18).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Whether Shoji (US Patent No. 5,378,553) is analogous art such that claims 1-13 and 15-30 are unpatentable under 35 U.S.C. 103(a) over Shoji in view of Grisamore (US Patent No. 6,132,055).
- B. Whether Sutherland (US Patent No. 5,641,220) is analogous art such that claims 3-5, 19-20, and 27-29 are unpatentable under 35 U.S.C. 103(a) over Shoji in view of Grisamore and Petzl (US Patent No. 6,499,859) and in further view of Sutherland.
- C. Whether Shoji, Grisamore, and Sutherland disclose all of the limitations of claim 3.
- D. Whether Shoji, Grisamore, Petzl, and Sutherland disclose all of the limitations of claims 4 and 19.
- E. Whether Shoji, Grisamore, Petzl, and Sutherland disclose all of the limitations of claims 5 and 20.
- F. Whether Shoji, Grisamore, Petzl, and Sutherland disclose all of the limitations of claims 15-30.

VII. ARGUMENT

A. Claims 1-13 and 15-30 are not obvious over Shoji in view of Grisamore.

The Appellants respectfully disagree with the Examiner's conclusions regarding the patentability of claims 1-13 and 15-30 over Shoji (US Patent No. 5,378,553) and Grisamore (US Patent NO. 6,132,055) in view of various other prior art. Each and every one of the Examiner's rejections is based upon the proposition that it is obvious to use the bicycle headlamp of Shoji on a barbecue grill merely. The Examiner supports his rejection on the basis that Grisamore suggests the need to illuminate the cooking area of a barbecue grill while Shoji suggests that an illumination device may be removably attached to a handle. The Examiner's reliance on Shoji and Grisamore to reject the claims is misplaced for at least the following reasons: (1) Shoji is not within the scope of the relevant art; (2) there is no motivation to combine Shoji and Grisamore, since Shoji merely suggests attaching a light to a *bicycle* handle (not a *barbecue grill* handle), and (3) evidence indicates that others have failed to make the combination deemed obvious by the Examiner.

1. Shoji is not within the scope of the relevant prior art

Shoji is not within the scope of the relevant prior art for purposes of obviousness under 35 U.S.C. 103(a) because it deals with a head lamp for bicycles and motorcycles, whereas the claimed invention relates to a removable lighting apparatus that is intended for use with a barbecue grill. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). This two-part test goes

to the heart of “whether one seeking to solve a problem with respect to the embodiment of a reference in one art would be apt to seek the solution to said problem in the other art.” *Application of Shapleigh*, 248 F.2d 96, 102 (CCPA 1957).

With the field of the Appellants’ endeavor properly defined and with proper consideration of the “reality of the circumstances,” Shoji cannot be considered to be within the scope of the relevant prior art. In the first place, the field of the Appellants’ endeavor should be restricted to lighting fixtures for barbecue grills. As such, Shoji, which teaches a headlamp for a bicycle, falls outside of that field. Secondly, the subject matter of Shoji is not even remotely pertinent to the problems with which the Appellants are concerned, as discussed in detail below.

a. Shoji is not within the same field of endeavor as the claimed invention

The first part of the *In re Oetiker* test is based on a fiction that inventors are charged with knowledge of references within the field of the applicant’s endeavor. Given that this test is based upon a fiction, it is appropriate to narrowly define the field of the Applicant’s endeavor. See *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998) (“agree[ing] that when the references are in the same narrow field as the applicant’s invention, knowledge thereof may be presumed”) (emphasis added). Indeed, the Federal Circuit has made it clear that it is inappropriate to consider a reference to be in the same field of endeavor merely because both the reference and the invention relate to the same industry. See *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (holding that “Sydansk cannot be considered to be within Clay’s field of endeavor merely because both relate to the petroleum industry”). In *In re Clay*, the Examiner rejected claims, which dealt with the introduction of gel into a man-made storage tank to fill in void space, on the basis of

Sydansk, a reference which taught the use of a gel in underground natural oil-bearing formations to channel flow in a desired direction. *Id.* The Federal Circuit took into consideration the differences in the characteristics of the use to find that the Sydansk reference was not within the field of the applicant's endeavor:

The [reference] process operates in extreme conditions, with petroleum formation temperatures as high as 115 degrees C and at significant well bore pressures; [the inventor's] process apparently operates at ambient temperature and atmospheric pressure. [The inventor's] field of endeavor is the *storage* of refined liquid hydrocarbons. The field of endeavor of [the reference] invention, on the other hand, is the *extraction* of crude petroleum.

Id.

Moreover, the Federal Circuit has made it clear that it is inappropriate to consider a reference to be in the same field of endeavor merely because the USPTO assigned the subject invention and the prior art reference to the same class. *See In re Huene*, 2000 U.S. App. LEXIS 19978 (Fed. Cir. 2000). The Federal Circuit has taken the position that, "as far as the matter of analogous prior art is concerned, evidence of classification of prior art . . . 'is inherently weak . . . because considerations in forming a classification system differ from those relating to a person of ordinary skill seeking a solution for a particular problem.'" *Id.* at *14 (citing *In re Mlot-Fijalkowski*, 676 F.2d 666, 670 (CCPA 1982)) (emphasis added). While the CCPA has found that similar classification is "*some evidence of analogy, [the CCPA considered] the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight.*" *In re Mlot-Fijalkowski*, 676 F.2d at 670 (italics in original, underlining added).

As established in *In re Clay*, *In re Huene*, and *In re Mlot-Fijalkowski* it is improper for the Examiner consider Shoji to be in the same field of endeavor as the claimed invention merely because both the reference and the invention relate in some way to the lighting industry or were similarly classified by the USPTO. Instead, the Applicants submit that the field of endeavor should be limited to light fixtures *for barbecue grills*. As clearly explained in the discussion of the application, the Appellants' invention is directed to a light fixture for attachment to a handle of a barbecue grill. In contrast, the Shoji device is directed to a headlamp for attachment to the handle of a bicycle. As discussed below, barbecue grill handles are substantially different from bicycle handles in both structure, function, and use. Under the standard set by the Federal Circuit and the CCPA, these differences show that the present invention is directed to a different field of endeavor than that of Shoji.

To begin with, bicycle handles are attached to bicycles at a pivot point, wherein the axis about which the bicycle handle rotates is *perpendicular* to the longitudinal axis of the handle. Notably, the pivot axis of a bicycle handle typically intersects the longitudinal axis of the bicycle handle, or is close thereby. Bicycle handles are used to steer a bicycle wherein the handle is rotated in a plane generally parallel to ground. Conversely, a barbecue grill handle is attached to the front of an upper member (or lid) of the grill which, in turn is hingedly attached at the rear to the lower member of the grill. As such, the grill handle rotates about an axis which is generally *parallel* to the longitudinal axis of the handle. Moreover, the rotational axis of a barbecue grill lid is significantly offset from the handle. With regards to use, barbecue grill handles are not

typically used to steer a direction of travel of a barbecue grill, but are instead used to open and close a barbecue grill lid.

The structural differences between a bicycle handle and a barbecue grill handle are recited in the rejected claims. For example, independent claim 1 sets forth that the upper member is hingedly secured to the lower member, while dependent claim 6 sets forth that the light fixture is fabricated to be connected to the upper member of the barbecue grill and dependent claim 7 sets forth that the light fixture is connected to the handle of the barbecue grill. Also, independent claim 15 sets forth that the barbecue grill has an upper member (with a handle) which is hingedly secured to a lower member (with a grilling surface). The light housing has a connector to securing the housing to the handle of the upper member. Dependent claim 26 specifies that the light pod is adapted to illuminate the grill surface. Independent claim 27 goes even further to require a hinged connection between an upper member and a lower member, wherein the grill has a handle (attached to the upper member) which has a longitudinal axis which is parallel to the pivot axis of the hinge. To conclude, it would be inappropriate to broadly construe the field of endeavor of the present invention considering that there are significant differences in the characteristics of structure and use of the invention as compared to Shoji.

b. The problems addressed by the present invention are substantially different than those addressed by Shoji

The second part of the *In re Oetiker* test goes to the heart of the question of “whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor.” *In re Oetiker*, 977 F.2d at 1447. The patent application at issue in *In re Oetiker* dealt with a

“hook” for a hose clamp. *Id.* The examiner in that case rejected the claims on the basis of a prior art reference which disclosed a hook used for garments, arguing that the prior art was analogous art because it was related to a hooking problem, just like *Oetiker*’s invention. *Id.* The Federal Circuit ultimately rejected the examiner’s argument and “reminded . . . the PTO that it is necessary to consider ‘the reality of the circumstances’” – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *Id.* (internal citations omitted). Specifically, the Federal Circuit held that a person of ordinary skill in the art, seeking to solve a problem of fastening a hose clamp, would not reasonably be expected or motivated to look to fasteners for garments. *Id.*

The Federal Circuit can be said to have considered the “reality of the circumstances” in the case of *In re Leonard M. Greene*, 1994 U.S. App. LEXIS 5103 (Fed. Cir. 1994). In that case the Federal Circuit overruled an appeals board finding of obviousness. The appeals board found that a patent claim for a breakaway aircraft vane was obvious in view of Dupuy which disclosed a breakaway blade for a pugging mill or mixer. The Federal Circuit disagreed with the appeals board and held that problems of broken blades in a pugging mill are not reasonably pertinent to problems of broken air vanes on aircraft. Likewise, the applicants respectfully assert that the problems of headlamps on bicycles are not reasonably pertinent to problems of light fixtures for grills.

The Examiner in this case is making a very similar argument to the one which was rejected by *In re Oetiker*, that since both Shoji and the present invention deal with lighting problems, Shoji must be analogous. The Examiner’s argument must be rejected because one lighting problem is not the same as another lighting problem, just like one

hooking problem is not the same as another hooking problem. Indeed, the lighting problems associated with Shoji are significantly different than the lighting problems associated with the present inventions.

For example, the problems of orienting a bicycle headlamp such that the lightbeam points in the direction of travel is substantially different than the problems associated with orienting a light fixture on a barbecue grill such that the grill cooking surface is illumination. As discussed in more detail above, the structure and operation of a bicycle handle is substantially different from that of a barbecue grill handle. Bicycle handles rotate about an axis which is generally perpendicular to the bicycle handle, while barbecue grill handles rotate about an axis which is generally parallel to the grill handle. Also, the axis of rotation for a bicycle handle generally passes through or closely thereby the bicycle handle. Conversely, the axis of rotation for a grill handle is substantially offset from the grill handle (i.e. grill handle is located at front of lid while hinge is located near the rear of the lid). Consequently, the way a bicycle handle moves as the bicycle is traveling is substantially different from the way a barbecue grill handle moves as the grill lid is opened and closed.

Moreover, the Shoji headlamp, which is fixed to the bicycle handle (which in turn is fixed to the front wheel), is always pointed in the bicycle's direction of travel. Using the bicycle as a frame of reference, the headlamp is directed at a *moving* surface, such as a sidewalk or a road. This is not the case for the light fixture of the present invention. The light fixture of the present invention is not pointed in the grill lid's direction of travel, but is instead pointed at an angle to the direction of travel. Furthermore, using the grill as a frame of reference, the light fixture of the present invention is directed at a *fixed*

surface, the grill cooking surface. For this reason, and for the reasons provided above, the problems associated with directing a headlamp in an appropriate direction during use of a bicycle are substantially different from the problems associated with directing a light fixture during use of a barbecue grill.

Considering the reality of the circumstances – i.e. the significant differences between a bicycle and a barbecue grill - a person of ordinary skill, seeking to illuminate the cooking surface of a barbecue grill, would not reasonably be expected or motivated to look to references which disclose bicycle headlamps. As such, Shoji cannot be considered reasonably pertinent to the particular problem with which the Applicant was concerned.

2. There is no motivation to combine Shoji with Grisamore

Second, the Examiner has failed to present a *prima facie* case of obviousness. Specifically, there is no motivation to combine Shoji and Grisamore. “Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestions for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992).

The Examiner purports that the motivation to combine comes from the cited prior art (i.e., Grisamore), rather than from the knowledge generally available to one of ordinary skill in the art. *See* Office Action of Feb. 7 2006. The Examiner claims that Grisamore suggests “necessary need to illuminate the cooking area onto the barbecue grill lid handle and refrence Shoji suggests that the illumination device may be removably attached to the handle or the like.” However, the Examiner ignores that Shoji

suggests attaching a headlamp to a *bicycle* handle, not a handle generally. Moreover, the Examiner ignores the obvious and significant differences between a bicycle handle and a barbecue grill handle, as discussed in detail above. Even if the Examiner is correct that Grisamore identifies a need to illuminate the cooking surface of the barbecue grill, there still is no motivation to modify the bike headlamp of Shoji to illuminate the cooking surface of a grill. There is nothing in Shoji that suggests using the headlamp in connection with a cooking device, much less the handle of a cooking device. Shoji doesn't even suggest using the headlamp as anything other than a bicycle headlamp. Along the same lines, nothing in Grisamore suggests using the handle light for a bicycle or attaching an external light fixture to the barbecue grill handle.

The facts and holding of *In re Fine* are especially analogous to the issue at hand. The invention at issue in *In re fine* called for a gas chromatograph, a converter, and a nitric oxide detector. *In re Fine*, 837 F.2d at 1072. The examiner in that case relied upon a first prior art patent which purportedly disclosed all limitations of the invention – with the exception that the prior art disclosed a sulfur detector instead of a nitric oxide detector – and a second prior art patent which taught the use of a nitric oxide detector. *Id.* at 1073. The examiner submitted, and the Federal Circuit rejected, the argument that substitution of one type of detector for another would have been within the skill of the art. *Id.* at 1074-1075. The Federal Circuit held that “teachings of references can be combined *only* if there is some suggestion or incentive to do so” *Id.* at 1075. Notably, the Federal Circuit reasoned that the first reference did not suggest using the arrangement to detect nitrogen compounds and actually warned about adverse affects caused by the presence of nitrogen.

The Examiner in this case makes an argument that is strikingly similar to the argument that was rejected in *In re Fine*. The Examiner argues that it would have been obvious to substitute a barbecue grill handle for a bicycle handle to arrive at the claimed invention, despite the fact that there are substantial differences between the handles (see argument above concerning non-analogous bike art). The Appellants do not disagree with the Examiner that Grisamore teaches a barbecue light where a grill handle is a light-containing tube or that Shoji teaches a headlamp that is attached to a bicycle grill handle. What the Appellants disagree with is that Grisamore would motivate a person of ordinary skill in the art to attach a light fixture to the outside surface of a grill handle or that Shoji would motivate a person of ordinary skill in the art to attach a bicycle headlamp to a barbecue grill handle. Indeed, Shoji does not suggest using the headlamp on a barbecue grill handle and Grisamore does not teach attaching a light to the exterior of a handle.

Moreover, Grisamore actually teaches away from attaching a light to the exterior of a grill handle. The Federal Circuit has said that “[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Referring specifically to col. 1, ll. 10-20, Grisamore explains that prior art, clamp-on light fixtures for barbecue grills that are designed to attach to nearby trays or other physical objects are cumbersome, awkward, and expensive and cast shadows on the cooking surface so as to obscure the desired view of food items being cooked. For this reason, the Applicant respectfully asserts that Grisamore teaches away from the invention because it discourages a person of ordinary skill in the art from “attaching” a device such

as that disclosed in Shoji to a grill handle. Thus, Grisamore cannot contain a motivation to combine Shoji with a barbecue grill handle to arrive at the present invention.

The Examiner citation to *In re Keller* for the argument that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references is misplaced. *See In re Keller*, 642 F.2d 413 (CCPA 1981). *In re Keller* is inapplicable to the instant case. *In re Keller* prohibits attacking references individually to show nonobviousness by objective evidence only after an Examiner has met his burden to put forth a *prima facie* case of obviousness; i.e. the Examiner must first show that it is appropriate to combine references. *Id.* at 425-426. Here, the Appellants argue that the Examiner has not met this burden. Specifically, the Appellants argue that the Examiner has failed to meet his burden to show that there exists a motivation to combine Shoji and Grisamore. As such, it is appropriate to attack individual references. The Appellant's arguments that Shoji does not suggest using the headlamp on a barbecue grill handle and that Grisamore does not suggest attaching a light to the exterior of a handle are no different than the arguments made by the Federal Circuit in *In re Jones*:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. We see no such suggestion in Zorayan, which is directed to shampoo additives, nor in Wideman, which teaches that the amine used to make the claimed compound is a byproduct of the production of morpholine. Nor does the broad disclosure of Richter fill the gap, for the reasons discussed above.

958 F.2d 347, 351 (Fed. Cir. 1992) (emphasis). Furthermore, because the Examiner specifically asserts that Grisamore contains the motivation to combine (see pages 16 and

17 of the office action – “there is a clear motivation that has been taught by the prior art reference Grisamore”), it is appropriate for the Applicant to attack Grismore individually on the basis that Grisamore teaches away from attaching lights to external surfaces of a grill and clearly does not suggest attaching a light to the external surface of a grill handle. *See In re Gurley*, 27 F.3d at 553 (“Gurley’s position appears to be that a reference that “teaches away” can not serve to create a prima facie case of obviousness. We agree that this is a useful general rule.”)

Even if the Examiner is correct that the Applicants may not attack references individually, the Applicants believe that Grismore and Shoji, when combined, do not suggest the Applicants invention. Grismore teaches a light-containing barbecue grill handle, whereas Shoji teaches an illumination device attached to a bicycle handle. While the Examiner seems to argue that a handle is a handle, the Applicants respectfully disagree and submit that a barbecue grill handle is not the same as a bicycle handle. Indeed, a barbecue grill handle is substantially different in structure and function than a bicycle handle (see the discussion above concerning the differences between the two). Consequently, even when Grisamore and Shoji are viewed in combination, there is no suggestion to attach a light fixture to a barbecue grill handle.

As neither Shoji nor Grisamore include the requisite motivation to combine, it is apparent that that the Examiner has improperly used hindsight (i.e., the Appellants’ invention) to obtain the combination. For this reason, the Examiner’s rejection of claims 1-13 and 15-30 should be overruled.

3. The art cited by the Examiner indicates that others have failed to make the combination suggested by the Examiner

Third, it is the Applicants belief that evidence of failure of others negatives the Examiner's obviousness rejection. See *Advanced Display Systems, Inc. v. Kent State University*, 212 F.3d 1272, 1285 (Fed. Cir. 2000) (holding that "evidence of failed attempts by others could be determinative on the issue of obviousness"). The Applicants believe that handlebar mounted bike lamps have been in existence long before the priority date of Shoji, March 13, 1992, given that Shoji is an improvement patent. Assuming that the Examiner is correct that Shoji discloses the claimed invention except for the light fixture being secured to a barbecue grill², approximately ten (10) years lapsed between date of invention of Shoji and the date of invention of the claimed invention. As discussed in Grisamore, others have attempted and failed to develop a light fixture for a barbecue grill which is not cumbersome, awkward and/or expensive. Grisamore, col. 1, ll. 10-20; see also the specification of the instant application, p. 1, l. 19 to p. 3, l. 15 (stating that the prior art grill lights are obtrusive, hazardous, complicated to operate, and reduce the surface area of the grill). For this reason,

B. Claims 3-5, 19-20, and 27-29 are not obvious over Sutherland.

The Examiner rejected claims 3-5 as being unpatentable over Shoji in view of Grisamore as applied to claim 1 and further in view of Sutherland and rejected claims 19-20 and 27-29 as being unpatentable over Shoji in view of Grisamore and Peztzl and further in view of Sutherland. However, Sutherland is not analogous art and, thus, cannot be relied upon to reject the Applicants' claims. Sutherland relates to a significantly

² Note that the Appellants do not admit that Shoji discloses the remaining limitations of the claims.

different application than the claimed invention and, therefore, is not analogous prior art. The device disclosed in Sutherland is “particularly designed for use with bicycles,” (see Sutherland, Abstract); whereas the claimed invention relates to a removable lighting apparatus that is intended for use with barbecue grills. One of ordinary skill in the art would not look to bicycle art in an attempt to develop a light for a barbecue grill because the problems associated with the bicycle art are significantly different than the problems associated with the grill art. For further information, see the discussion above concerning another bicycle patent cited by the Examiner, Shoji.

C. The art cited by the Examiner does not disclose all of the limitations of claim 3.

The Examiner asserts that Shoji in view of Grisamore discloses the claimed invention, except for an additional or second lighting device that is in connection with the first lighting device. It is the Examiner’s position that Sutherland teaches “multiple or two lighting device [sic] that is in connection with the first light device.” However, claim 3 calls for a single fixture to have a plurality of first mating members for engaging with corresponding mating members of the pods, while Sutherland teaches a plurality of fixtures, one for each headlamp. As such, the claimed invention comprises fewer parts than the light fixture of the prior art. As is well known by a person of ordinary skill in the art, a device which is comprised of fewer parts is generally less expensive to manufacture and simpler to install.

D. The art cited by the Examiner does not disclose all of the limitations of claims 4 and 19.

The Examiner asserts that Sutherland discloses a first pod and a second pod, each of which have their own internal power source and switches to independently manipulate

illumination of the respective pod. The Examiner is mistaken on this point. In fact Sutherland calls for the first and second pods to share a power source (i.e. the battery pack 110). Sutherland, col. 8, ll. 16-38. Because the dual headlamps of Sutherland share a power source, the two headlamps cannot be used independently of one another. Conversely, the light pods of the claimed invention have independent power sources allowing each to be used concurrently at different locations.

E. The art cited by the Examiner does not disclose all of the limitations of claims 5 and 20.

The Examiner claims that Sutherland discloses that the fixture has a handle portion between the first and second pod. The Examiner is mistaken on this point. Neither one of the two fixtures disclosed by Sutherland has a handle portion. As discussed above, Sutherland discloses two fixtures, each having one headlamp. Conversely, the claimed invention calls for one fixture which engages with two light pods. The fixture of the claimed invention itself incorporates a handle portion between the two pods. The fixture of Sutherland does not incorporate such a handle portion.

F. The art cited by the Examiner does not disclose all of the limitations of claims 15 and 27.

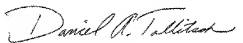
The Examiner rejected independent claims 15 and 27 as being unpatentable over some combination of Shoji, Grisamore, Petzl (US Patent No. 5,378,553) and Sutherland. However, the Examiner has failed to show how the cited art discloses the limitations of claims 15 and 27 calling for *modular* first and second mating members. The modular configuration of the first and second mating members allows the pods to be attached to various housings at different locations and allows housings at different locations to receive various pods. See para. [0082], [0090], [00100].

For the reasons advanced above, Appellant respectfully contends that each claim is patentable. Therefore, reversal of all rejections is respectfully requested.

February 5, 2007

Respectfully,

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A handwritten signature in cursive script, reading "Daniel A. Tallitsch", written in black ink on a white background.

Daniel A. Tallitsch

Reg. No. 55,821

VIII. CLAIMS APPENDIX

Claim 1. (previously presented): In a barbecue grill having an upper member and a lower member defining a cooking chamber, the cooking chamber having a cooking grid, the upper member being hingedly secured to the lower member, the upper member covering the lower member in a closed position, the improvement comprising a light, wherein the light comprises:

a fixture having a first mating member, the fixture being fabricated to be secured to the barbecue grill;

a removable first pod having an illumination device and a second mating member, the second mating member of the first pod removably engaging the first mating member of the fixture to removably secure the first pod to the fixture.

Claim 2. (previously presented): The barbecue grill of claim 1, wherein the first pod has a first internal power source and a first switch to independently manipulate illumination of the illumination device of the first pod when the first pod is engaging the fixture, and when the first pod is removed from the fixture.

Claim 3. (previously presented): The barbecue grill of claim 1, wherein the fixture has a plurality of first mating members, wherein the second mating member of the first pod removably engages one of the plurality of first mating members on the fixture to removably secure the first pod to the fixture, and further comprising a removable second pod having an illumination device and a second mating member, the second mating member of the second pod removably engaging one of the plurality of first mating members on the fixture to removably secure the second pod to the fixture.

Claim 4. (previously presented): The barbecue grill of claim 3, wherein the first pod has a first internal power source and a first switch to independently manipulate illumination of the illumination device of the first pod, and wherein the second pod has a second internal power source and a second switch to independently manipulate illumination of the illumination device of the second pod.

Claim 5. (previously presented): The barbecue grill of claim 3, wherein the fixture has a handle portion between the first pod and the second pod.

Claim 6. (previously presented): The barbecue grill of claim 1, wherein the fixture is fabricated to be connected to the upper member of the barbecue grill.

Claim 7. (previously presented): The barbecue grill of claim 1, wherein the fixture is fabricated to be connected to a handle of the barbecue grill.

Claim 8. (previously presented): The barbecue grill of claim 7, wherein the fixture has a spring connector portion for connecting the fixture to the handle of the grill.

Claim 9. (previously presented): The barbecue grill of claim 1, wherein the illumination device comprises a plurality of light emitting diodes, the light emitting diodes being directionally focused in varying directions.

Claim 10. (previously presented): The barbecue grill of claim 1, wherein the first mating member depending from the fixture is one of a male protrusion or a female receiver, and wherein the second mating member depending from the pod is the other of the male protrusion or female receiver.

Claim 11. (previously presented): The barbecue grill of claim 10, wherein the male protrusion and the female receiver mate in a frictional fit to secure the pod to the fixture.

Claim 12. (previously presented): The barbecue grill of claim 10, wherein one of the male protrusion and the female receiver has a stop to position the pod on the fixture.

Claim 13. (previously presented): The barbecue grill of claim 1, wherein the pod has a manual switch to manipulate illumination of the illumination device.

Claim 14. (previously presented): The barbecue grill of claim 13, wherein the pod has an automatic tilt sensor that moves between an open position and a closed position based on the position of the pod connected to the fixture, wherein the automatic tilt sensor is electrically connected to the manual switch and provides an override to the manual switch to turn the illumination device off when the upper member of the barbecue grill is in a closed position.

Claim 15. (previously presented): In a barbecue grill having an upper member and a lower member defining a cooking chamber, the lower member having a grilling surface, the upper member having a handle and being hingedly secured to the lower member, the improvement comprising a modular light, wherein the modular light comprises :

a housing having a connector to secure the housing to the handle of the barbecue grill and having a first mating member;

a removable first pod having an illumination device and a second mating member, the second mating member of the first pod removably connecting the first mating member of the housing to removably secure the first pod to the housing, the first pod having an independent internal power source located within the first pod for illuminating the illumination device of the first pod, and the first pod having a manual switch

electrically connected to the internal power source to control illumination of the illumination device; and,

the first mating member and the second mating member being modular.

Claim 16. (previously presented): The barbecue grill of claim 15, wherein the second mating member of the first pod slidably engages the first mating member of the housing to removably connect the first pod to the housing.

Claim 17. (previously presented): The barbecue grill of claim 15, wherein the illumination device comprises a plurality of light emitting diodes.

Claim 18. (previously presented): The barbecue grill of claim 17, wherein the light emitting diodes of the illumination device are directionally focused in varying positions.

Claim 19. (previously presented): The barbecue grill of claim 15, wherein the housing has a plurality of first mating members, wherein the second mating member of the first pod removably engages one of the plurality of first mating members on the housing to removably secure the first pod to the housing, and further comprising a removable second pod having an illumination device and a second mating member, the second mating member of the second pod removably engaging one of the plurality of first mating members on the housing to removably secure the second pod to the housing, the second pod having an independent internal power source located within the second pod for illuminating the illumination device of the second pod, and the second pod having a manual switch electrically connected to the internal power source to control illumination of the illumination device of the second pod.

Claim 20. (previously presented): The barbecue grill of claim 19, wherein housing has a handle portion for grasping by a user, the handle portion located between the first pod and the second pod when first and second pods are removably secured to the housing.

Claim 21. (previously presented): The barbecue grill of claim 15, wherein the illumination device is a plurality of light emitting diodes.

Claim 22. (previously presented): The barbecue grill of claim 15, wherein the first mating member removably engages the second mating member without hardware.

Claim 23. (previously presented): The barbecue grill of claim 15, wherein the housing has a first connector to secure the housing to the barbecue grill.

Claim 24. (previously presented): The barbecue grill of claim 15, wherein the housing has a spring member to secure the housing to the barbecue grill.

Claim 25. (previously presented): The barbecue grill of claim 15, wherein an extension depends from the housing, and wherein the extension has a first connector the secure the extension to a surface.

Claim 26. (previously presented): The barbecue grill of claim 15, wherein the pod is adapted to illuminate the grilling surface of the grill when the pod is connected to the housing.

Claim 27. (previously presented): In a barbecue grill having an upper member, a lower member, a hinge, and a handle, the hinge securing the upper member to the lower member such that the upper member rotates about a horizontal axis, the upper member covering the lower member in a closed position, the upper member and the

lower member defining a cooking chamber, the cooking chamber having a cooking grid, the handle being attached to the upper member and being generally parallel to the horizontal axis, the improvement comprising a modular light, wherein the modular light comprises:

a housing being attached to the handle of the barbecue grill and having a plurality of first mating members;

a removable first pod having an illumination device and a second mating member, the second mating member of the first pod removably connecting to one of the first mating members of the housing to removably secure the first pod to the housing, the first pod having an independent internal power source located within the first pod for illuminating the illumination device of the first pod, and the first pod having a manual switch electrically connected to the internal power source to control illumination of the illumination device of the first pod;

a removable second pod having an illumination device and a second mating member, the second mating member of the second pod removably connecting to another of the first mating members of the housing to removably secure the second pod to the housing, the second pod having an independent internal power source located within the second pod for illuminating the illumination device of the second pod, and the second pod having a manual switch electrically connected to the internal power source to control illumination of the illumination device of the second pod; and,

the plurality of first mating members of the housing and the second mating members of the first pod and second pod being modular.

Claim 28. (previously presented): The barbecue grill of claim 27, wherein the second mating members of the first and second pods slidably engage the respective first mating members of the housing to independently removably connect the first and second pods to the housing.

Claim 29. (previously presented): The barbecue grill of claim 27, wherein the illumination devices of the first and second pods comprises a plurality of light emitting diodes.

Claim 30. (previously presented): The barbecue grill of claim 27, wherein the housing is fabricated in a two part mating configuration to be removably connected around a portion of a handle of a barbecue grill.

Claim 31. (withdrawn): A light for a barbecue grill, the barbecue grill having a lower housing with a cooking grid, and a lid that covers the lower housing when the lid is in a closed position, the light comprising:

a light housing having a light source, the light housing mounted to the lid of the barbecue grill, an automatic switch connected to the light source wherein the automatic switch is a timer, the automatic switch manipulating illumination of the light source, and a manual switch on the light housing providing an override to the automatic switch for controlling illumination of the light source.

Claim 32. (withdrawn): The light of claim 31 wherein the light housing is mounted to the lid with an integral c-shaped threaded clamping device.

Claim 33. (withdrawn): The light of claim 32 wherein the light housing is attached to the clamping device by an articulating connection.

Claim 34. (withdrawn): The light of claim 32 wherein the light housing is attached to the clamping device by an adjustable connection.

Claim 35. (withdrawn): The light of claim 31 wherein the timer turns the light source off after a period of time.

Claim 36. (withdrawn): The light of claim 35 wherein the manual switch overrides the timer by turning the light source off before the period of time has elapsed.

Claim 37. (withdrawn): A light for a barbecue grill, the barbecue grill having a lower housing with a cooking grid, and a lid that covers the lower housing when the lid is in a closed position wherein the lid has a handle, the light comprising:

a housing integral with a clamping member;

the housing having a light source and a timer connected to the light source; and,

the clamping member being mounted to the handle of the barbecue grill.

Claim 38. (withdrawn): The light of claim 37 wherein the clamping member is a c-shaped threaded clamping device.

Claim 39. (withdrawn): The light of claim 38 wherein the light housing is attached to the c-shaped threaded clamping device by an articulable connection.

Claim 40. (withdrawn): The light of claim 38 wherein the light housing is attached to the c-shaped threaded clamping device by an adjustable connection.

Claim 41. (withdrawn): The light of claim 37 wherein the timer turns the light source off after a period of time.

Claim 42. (withdrawn): The light of claim 41 wherein the light further comprises a manual switch for providing an override to the timer to turn the light source off before the period of time has elapsed.

Claim 43. (withdrawn): A light for a barbecue grill, the barbecue grill having a lower housing with a cooking grid, and a lid that covers the lower housing when the lid is in a closed position wherein the lid has a handle, the light comprising:

- a housing attached to a clamping member by an articuable connection;
- the housing having a light source and a timer connected to the light source; and,
- the clamping member being mounted to the handle of the barbecue grill.

Claim 44. (withdrawn): A light for a barbecue grill, the barbecue grill having a lower housing with a cooking grid, and a lid that covers the lower housing when the lid is in a closed position wherein the lid has a handle, the light comprising:

- a housing attached to a c-shaped clamping device by an articuable connection;
- the housing having a light source, a manual switch, and a timer wherein the manual switch and timer are connected to the light source;
- the timer turning the light source off after a period of time;
- the manual switch providing an override to the timer by turning the light source off before the period of time has elapsed; and,
- the clamping member being mounted to the handle of the barbecue grill.

IX. EVIDENCE APPENDIX

No evidence submitted.

X. RELATED APPEALS AND INTERFERENCES APPENDIX

None.